

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM ANDREW BOTTING

Appeal No. 2000-2175
Application No. 09/268,925

ON BRIEF¹

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and
NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 5, mailed December 2, 1999) of claims 1 to 15, which are all of the claims pending in this application.

¹ On February 22, 2001, the appellant waived the oral hearing (see Paper No. 10) scheduled for March 21, 2001.

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We REVERSE.

BACKGROUND

The appellant's invention relates to a folded and hinged plastic connector for use with heating, ventilation and air conditioning (HVAC) duct work (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Meyer, Jr. (Meyer)	3,578,026	May 11, 1971
Ono et al. (Ono)	4,891,471	Jan. 2, 1990
Botsolas	5,158,114	Oct. 27, 1992

The following grounds of rejection are set forth in the examiner's answer (Paper No. 8, mailed April 21, 2000):

1. Claims 1-3, 6, 7, 9, and 15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono.²

² In the final rejection, the examiner rejected claims 1-3, 6, 7, and 9 under 35 U.S.C. § 102(b) as being anticipated by Ono. In our discussion below with regard to this ground of
(continued...)

2. Claims 1-3 and 5-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by Meyer.

3. Claims 4 and 10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ono.

4. Claims 11-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Botsolas.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and the answer for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 7, filed April 3, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the

²(...continued)
rejection we will treat claims 1-3, 6, 7, 9, and 15 as being rejected under both 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejections based on Ono

We will not sustain the rejection of claims 1-4, 6, 7, 9, 10 and 15 based on Ono.

A prior art reference anticipates a claim only if the reference discloses, either expressly or inherently, every limitation of the claim. See Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Absence from the reference of any claimed element negates anticipation. See Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986). Similarly, a case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993).

The issue raised by the appellant and the examiner in this appeal is whether the claim phrase "HVAC plastic duct connector," which appears in the preamble of independent claims 1 and 7, is or is not an affirmative limitation of the claim.

The examiner has interpreted the claim as drawn to the subject matter of a duct connector of general utility and gave no meaning to the word "HVAC." On this basis, the examiner concluded that the Ono patent, which admittedly discloses only a wiring harness protector, anticipated or rendered obvious the appellant's claims 1 and 7. The appellant urges that the examiner erred in failing to limit the claims at issue to a HVAC plastic duct connector.

"[A] claim preamble has the import that the claim as a whole suggests for it." See Bell Communications Research, Inc. v. Vitalink Communications Corp., 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). Where an appellant uses the claim preamble to recite structural limitations of his claimed invention, the USPTO and courts give effect to that usage. See id.; Corning Glass Works v. Sumitomo Elec. U.S.A., Inc., 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). Conversely, where an appellant defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation. See Bell Communications, 55 F.3d at

620, 34 USPQ2d at 1820; Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The determination of whether preamble recitations are structural limitations or mere statements of purpose or use "can be resolved only on review of the entirety of the application to gain an understanding of what the inventor actually invented and intended to encompass by the claim. See Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966. The inquiry involves examination of the entire application record to determine what invention the appellant intended to define and protect. See Bell Communications, 55 F.3d at 621, 34 USPQ2d at 1821 (looking to patent specification to determine whether claimed invention includes preamble recitations); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994) (examining "patent as a whole"); Vaupel Textilmaschinen KG v. Meccanica Euro Italia SPA, 944 F.2d 870, 880, 20 USPQ2d 1045, 1053 (Fed. Cir. 1991) (looking to claims, specification, and drawings); Gerber Garment Tech., Inc. v. Lectra Sys., Inc., 916 F.2d 683, 689, 16 USPQ2d 1436, 1441 (Fed. Cir. 1990) (noting that preamble recitations provided antecedent basis for

terms used in body of claim); Corning Glass Works, 868 F.2d at 1257, 9 USPQ2d at 1966 (considering the specification's statement of the problem with the prior art); Kropa, 187 F.2d at 152, 88 USPQ at 481 (noting that preamble sets out distinct relationship among remaining claim elements).

Inspection of the entire record in this case reveals that "HVAC plastic duct connector" is, in fact, a structural limitation of claims 1 and 7. To begin with, the term "HVAC" was added to the preamble of claims 1 and 7 in the amendment filed on September 14, 1999 (Paper No. 4) to distinguish those claims from the applied prior art. Additionally, the appellant's specification clearly indicates that the inventor was working on a particular problem concerning HVAC duct connectors used in heating, ventilation and air conditioning systems (i.e., systems that use a network of ducts to deliver the heated and/or cooled air to various rooms and spaces within a building structure) and not general improvements to all ducts. In our opinion, to read claims 1 and 7 indiscriminately to cover all types of ducts would be divorced from reality. The invention so described is restricted to those HVAC plastic

duct connectors that work to deliver heated and/or cooled air to various rooms and spaces within a building structure, which is not true with respect to all duct connectors recited in just the body of claims 1 and 7. Thus, we conclude that the claim preamble in this instance does not merely state a purpose or intended use for the claimed structure. Rather, those words do give "life and meaning" and provide further positive limitations to the invention claimed.

In view of the above-noted determinations, we conclude that the wiring harness protector of Ono does not anticipate or render obvious the subject matter of claims 1 and 7. Accordingly, the decision of the examiner to reject independent claims 1 and 7, and claims 2-4, 6, 9, 10 and 15 dependent thereon, based on Ono is reversed.

The rejection based on Meyer

We will not sustain the rejection of claims 1-3 and 5-9 under 35 U.S.C. § 102(b) as being anticipated by Meyer.

In view of the determinations made above that the words "HVAC plastic duct connector" as recited in claims 1 and 7 do give "life and meaning" and provide further positive limitations to the invention claimed, we conclude that the hose jacket of Meyer does not anticipate the subject matter of claims 1 and 7. Accordingly, the decision of the examiner to reject independent claims 1 and 7, and claims 2, 3, 5, 6, 8 and 9 dependent thereon, based on Meyer is reversed.

The rejection based on Botsolas

We will not sustain the rejection of claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Botsolas.

The record is clear that the examiner has given little or no patentable weight to the "providing" step of claim 11 or the "connecting" steps of claim 11 (see answer, p. 5). This is clearly in error. Under 35 U.S.C. § 103 all words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, it is well established that the materials on which a process is carried out must be

accorded weight in determining the obviousness of that process. See In re Pleuddemann, 910 F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed. Cir. 1990); In re Kuehl, 475 F.2d 658, 664-65, 177 USPQ 250, 255 (CCPA 1973); Ex parte Leonard, 187 USPQ 122, 124 (Bd. App. 1974). In our view, the case law clearly establishes that the position of the examiner in this case is in error. That is, the particular structure recited in the "providing" step of claim 11 cannot be ignored under 35 U.S.C. § 103. Likewise, the particular structure recited in the "connecting" steps of claim 11 cannot be ignored under 35 U.S.C. § 103. When that structure is given weight as required under 35 U.S.C. § 103, it is clear that the examiner has not established that the subject matter of claim 11 would have been obvious at the time the invention was made to a person having ordinary skill in the art. For example, connecting the plastic duct connector at one end to heating, ventilation or air conditioning duct work and connecting the plastic duct connector at another end thereof, to a register opening or other heating, ventilation or air conditioning duct work is not taught by Botsolas and the examiner has not set forth any basis as to why such limitations would have been obvious at the time

the invention was made to a person having ordinary skill in the art from the teachings of Botsolas.

For the reasons set forth above, the decision of the examiner to reject claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over Botsolas is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject
claims 1 to 15 is reversed.

REVERSED

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge
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LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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